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OFFICE OF PETITIONS

In re Application of :
TRACY D. MALLORY : DECISION ON APPLICATION
Application No. 09/825,708 : FOR PATENT TERM ADJUSTMENT
Filed: 04/04/2001 :
Atty Docket No. 033-051001 :

This is a decision on the "REQUEST TO CORRECT PATENT TERM ADJUSTMENT," filed November 20, 2007. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from 736 days to 780 days.

The application for patent term adjustment is DISMISSED.

On September 6, 2007, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 736 days. On November 20, 2007, applicants timely submitted the instant application for patent term adjustment¹. Applicants dispute the reduction pursuant to 37 CFR 1.704(c)(8) of 44 days.

A review of the application history supports a conclusion that the number of days adjusted for Office delay and the number of days reduced for applicants' delay is correct.

¹ The Office records show that the issue fee was also received on November 20, 2007.

Applicants assert:

In the detailed calculation of the PTA on the Patent Application Information Retrieval system (a copy of which is attached herewith), it is indicated that the PTA was reduced by 44 days in connection with a timely filed Information Disclosure Statement that was filed on January 10, 2007. This IDS was filed before Final Action and a \$180 fee was paid along with the IDS. The filing of an IDS before final action does not constitute a failure to engage in reasonable efforts to conclude prosecution of the application. ...

Petition, 11/20/07, p. 1.

Applicants' assertion is without merit. The fact that applicants submitted the IDS, accompanied by the fee set forth in § 1.17(p), on January 10, 2007, before the mailing date of any of final action under § 1.113 or notice of allowance under § 1.311 is irrelevant in determining patent term adjustment.¹

Applicants were properly assessed a delay under 37 CFR 1.704(c)(8) for submission of a supplemental reply or paper after a reply had been filed, without the express request of the examiner.

Pursuant to 37 CFR 1.704(c)(8):

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly

¹ 37 CFR 1.97(c) states:

An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application, and it is accompanied by one of:

- (1) The statement specified in paragraph (e) of this section; or
- (2) The fee set forth in § 1.17(p).

requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed[.]

It is undisputed that applicants submitted an IDS on January 10, 2007, after filing an initial response on November 27, 2006, to the nonfinal Office action. The record does not support a conclusion that the examiner expressly requested the IDS. Further, a review of the IDS, filed January 10, 2007, reveals that applicants did not include a statement under 37 CFR 1.704(d).⁴ Thus, applicants failed to engage in reasonable efforts to conclude prosecution of the application.

In accordance with 37 CFR 1.704(c)(8), the period of adjustment was correctly reduced by 44 days, the number of days beginning on the day after the date the initial reply was filed, November 28, 2006, and ending on the date that the IDS was filed, January 10, 2007.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance will remain 736 days.

The \$200.00 fee set forth in 37 CFR 1.18(e) will be charged to the Deposit Account as authorized. No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent.

⁴ Pursuant to 37 CFR § 1.704(d):

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

Telephone inquiries specific to this matter should be directed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.

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